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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/884,388	06/19/2001	Xi Yuan Hua	J6662(C)	3575
201	7590	10/22/2003	EXAMINER	
			SHARAREH, SHAHNAM J	
		ART UNIT		PAPER NUMBER
		1617		S
DATE MAILED: 10/22/2003				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/884,388	HUA ET AL.	
	Examiner	Art Unit	
	Shahnam Sharareh	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 6/19/2001.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Pri rity under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6-7.
- 4) Interview Summary (PTO-413) Paper No(s). _____.
 5) Notice of Informal Patent Application (PTO-152)
 6) Other:

DETAILED ACTION

Claims 1-8 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 4 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 4 recites the limitation "nonionic," which lacks proper antecedent basis. This claim appears to be a literal translation into English from a foreign document and contains an idiomatic error. The proper antecedent appears to be "nonionic surfactant."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Foerster et al US Patent 5,980,874.

The instant claims are directed to microemulsion compositions comprising (a) an oil which is capable of dissolving at least 20% triolein and having spreadability factor S' of greater than 0.3 to less than 2.5, (b) a surfactant, (c) a C2-C10 alcohol, (d) optionally water soluble polyalcohols or humectants and (e) water.

Forester discloses microemulsions comprising a fatty component such as octyl dodecanol in amounts of about 6.5% wt, a non-ionic surfactant in amounts of about 20% wt comprising alkyl glycoside with or without ethylene oxide products of fatty alcohols, co-emulsifier including linear or branched C8-C10 fatty alcohols, ethanol or isopropanol in amounts of about 2%, a thickening agent or perfume oil that meets the limitations of instant sensory agents, and a humectant such as propylene glycol (see abstract; col 3, lines 5-22 and 56-66; col 4, lines 24-67; col 5, lines 32-36; examples 1-5; and claims 1-2, 9-14). The amounts of co-surfactants used by Forester meet the limitations of the instantly claimed cosurfactant because Forester claims his ratio of nonionic emulsifier/coemulsifier as 2:1 to 15:1 (see claims 14). Since Forster claims up to 30% nonionic surfactant, the amounts of coemulsifier of Forster would fall within the instantly claimed ranges. The oils used by Forester are the same as those instantly claimed, because the instant specification at page 11 enumerates octyl dodecanol, coco caprylate/caprate and isopropyl myristate as such oils. Therefore, Forester meets all elements of the instant claims and thus anticipates the instant claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Forester et al US Patent 5,980,874.

The teachings Forester are described above. Forester further states that other nonionic surfactants such as addition products of ethylene oxide with fatty alcohols containing 16 to 22 carbon atoms or with partial esters of polyols containing 3 to 6 carbon atoms may be used as the nonionic surfactant because they provide the same function as other nonionic surfactants (see col 3, lines 57-65). Polyoxyalkylenated alcohols encompass the addition products of ethylene oxide with fatty alcohols

containing 16 to 22 carbon atoms or with partial esters of polyols containing 3 to 6 carbon atoms or the term polyol ethers. Thus, Forester provides for use of such surfactants. Forester fails to explicitly use polyoxyalkylenated alcohols as the nonionic surfactant in an exemplified product.

However, as recognized by Forester, polyoxyalkylenated alcohols are functional equivalent surfactants to alkyl glycosides. Thus, substituting polyoxyalkylenated alcohols in place of alkyl glycosides of Forester would have been obvious and well within the level of ordinary skill in the art.

Moreover, even though Forester provides the use of C8-C10 as suitable cosurfactant in 0.2 to 1.2 parts by weight in the oil phase in ratios of 1:2 to 1:10 with the emulsifier, he fails to explicitly teach that the use of C2-C10 in amounts of about 3 to 10% of his microemulsion.

Nevertheless, absence of showing unexpected results, it would have been obvious to one of ordinary skill in the art at the time of invention to optimize the amount of such fatty alcohols coemulsifiers to improve stability of the microemulsions of Forester.

Conclusion

No claims are allowed. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shahnam Sharareh whose telephone number is 703-306-5400. The examiner can normally be reached on 8:30 am - 6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, PhD can be reached on 703-308-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1123.



Shahnam Sharareh, PharmD
Patent Examiner, AU 1617

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10/16/03